

REMARKS

Claim 16 remains pending. This claim was allowed, as indicated in the Notice of Allowance dated June 2, 2004. Claim 16 was merely amended to improve its form using U.S. claims drafting practice.

This submission is concurrently filed with a Request for Continued Examination in order to amend the Specification and Drawings to correct an error regarding the status of Figures 3, 4A, and 4B, as well as errors in the light intensity distribution curve depicted in Figure 3. These errors were recently discovered by the inventor, Takeo Tanaami.

In particular, Figure 3 is not “prior art.” Instead, Figure 3 is based on the subject matter described in the inventors’ related Japanese Patent Application No. 2001-2264. Basically, Figure 3 relates to the inventors’ own work. Figures 4A and 4B relate to Figure 3. All references to Figures 3, 4A and 4B as being “prior art” or being “conventional” in the specification and drawings are incorrect. As indicated on page 4, lines 17 – 20, “Figure 3 is a schematic view of the biochip reader using a microlens array system illustrating its principle and configuration, mentioned in Japanese Patent Application No. 2001-2264 *submitted by the applicant concerned.*” The Applicants of the present U.S. application are the same Applicants of Japanese Patent Application No. 2001-2264 (see, also, U.S. Patent No. 6,494,373, submitted with the concurrently filed Information Disclosure Statement).

A Declaration Under 37 C.F.R. §1.132 executed by Takeo Tanaami, one of the inventors of the present application, is attached to attest to the origins of the subject matter described in Figure 3 of the present application in support of the present corrections thereto.

Neither Japanese Patent Application No. 2001-2264 nor its corresponding U.S. Patent No. 6,494,373 constitute prior art under any provision of 35 U.S.C. §102. As stated by the Federal Circuit in *Riverwood Int'l Corp. v. R. A. Jones & Co., Inc.*, 324 F.3d 1346, 66 U.S.P.Q. 2d 1331, (Fed. Cir., 2003), “one’s own work may not be considered prior art in the absence of a statutory basis.” According to the Federal Circuit’s Decision in *Riverwood*, Applicant’s are permitted to correct mistaken admissions of “prior art” when such mistaken “prior art” was actually the Applicant’s own work. As mentioned above, and as supported by the attached Declaration from one of the inventors, Figures 3, 4A and 4B are based on the Applicants’ own work. The mistake in labeling and describing the subject matter of these drawings as prior art arose without any deceptive intent, and are being corrected by this Submission. It is submitted that no new matter was added.

The light intensity distribution curve depicted in Figure 3 was also corrected by this amendment. In particular, the specification stated that the light intensity distribution curve depicted in Figure 3 has the ratio α as 10 – 20% (see e.g. page 5, lines 15 – 19). However, the originally depicted ratio α in Figure 3 looks substantially similar to the ratio α of the light intensity distribution curve depicted in Figure 16. This is incorrect. The light intensity distribution curve depicted in Figure 3 having the ratio α as 10 – 20% should be noticeably different than the light intensity distribution curve depicted in Figure 16 that is described in the present specification to have the ratio α of about 90% (see e.g. page 17, line 22 to page 18, line 1). Accordingly, Figure 3 was corrected above to better reflect the description thereof in the specification. Again, no new matter was added.

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Submission Under 37 C.F.R. §1.114 dated September 1, 2004

Attorney Docket No. 020349C

Pending claim 16 was already allowed. Therefore, the present application is in condition for allowance. If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 50-2866.

Respectfully Submitted,

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Enclosures: 1 sheet of Corrected Formal Drawing (Figs. 3, 4A and 4B);
Rule 132 Declaration
Information Disclosure Statement (with 1 reference).

Amendments to the Drawings

The attached one sheet of drawings is the *replacement* corrected *formal* sheet of drawings including changes to Figs. 3, 4A, and 4B. The light intensity distribution curve depicted in Figure 3 was corrected to correspond with the description in the present specification to have the ratio α as 10 – 20% (see e.g. page 5, lines 15 – 19), which should be noticeably different than the light intensity distribution curve depicted in Figure 16 that is described in the present specification to have the ratio α of about 90% (see e.g. page 17, line 22 to page 18, line 1).

Attachment: 1 Replacement Sheet (including Figures 3, 4A and 4B)